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13773-7/225.P2/CO89.US.CP5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

LINK, et al.

Serial No.: 09/541,795

Filed: March 31, 2000

For: CELL ADHESION-INHIBITING
ANTIINFLAMMATORY AND
IMMUNE-SUPPRESSIVE
COMPOUNDS

) Art Group: 1624
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) Examiner: PATEL, S.
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DISCLOSURE UNDER 37 CFR § 1.56

Commissioner for Patents
Washington, D.C. 20231

Sir:

5 In fulfilling the duty of candor and good faith, the documents listed on the attached PTO-1449 (two copies) are disclosed to the Office in accordance with 37 CFR § 1.56. It should be noted the word "prior" has been deleted from the attached PTO-1449. It is not admitted that the information in the listed documents is material to patentability as defined in 37 CFR § 1.56(b) or that the documents are analogous art. The Examiner is asked to consider 10 these documents, and to confirm such consideration by returning an initialed and signed copy of the PTO-1449.

15 **CERTIFICATE OF MAILING:** I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on July 29, 2002.

Printed Name: KIRA LUTCHENKOVA

20 Kira Lutchenko July 29, 2002
Signature Date

A copy of each of the documents listed on the attached PTO-1449 is attached. Insofar as the attached copies have markings thereon, no significance is intended by such markings.

One of the documents listed on the attached PTO-1449 is application Serial No. 5 09/285,325 (Docket No. 13784, Case 181). Serial Number 09/285,325 was filed on April 2, 1999, which is after the first priority date claimed by this application (December 29, 1998). As more fully disclosed in Serial No. 09/285,325 itself, Serial No. 09/285,325 discloses diaryl sulfides useful as negative regulators of LFA-1 binding to natural ligands. None of the diaryl sulfides disclosed in Serial No. 09/285,325 contains a cinnamide group. Applicants have 10 become aware of the possibility that the information disclosed in Serial No. 09/285,325 may be prior art under 35 U.S.C. 102(g) and 35 U.S.C. 103 to the claims of this Patent. Therefore, the Examiner is asked to carry out the *ex parte* examination of this application on the basis that the information disclosed in Serial No. 09/285,325 is "prior art" under 35 U.S.C. 102(g) and 35 U.S.C. 103.

15 Another document listed on the attached PTO-1449 is application Serial No. 09/285,477 (Docket 13783, Case 180). Serial No. 09/285,477 was filed on April 2, 1999, which is after the first priority date claimed by this application (December 29, 1998). As more fully disclosed in Serial No. 09/285,477 itself, Serial No. 09/285,477 discloses test methods of identifying negative regulators of LFA-1 binding to natural ligands; pharmaceutical 20 compositions comprising, and methods of treatment using, negative regulators so-identified; methods of identifying amino acids in a regulatory site to which the negative regulators bind; certain mutant polypeptides; and a certain monoclonal antibody. The test methods can make use of various diaryl sulfides, some of which are diaryl sulfides containing cinnamide groups (see, for example, page 13, lines 17 to 27). The negative regulators can be one of the diaryl sulfides disclosed in two applications which were filed on the same day as Serial No. 25 09/285,477 and which are incorporated by reference (see, page 15, lines 6-11). These two applications were allocated Serial No. 09/286,645 and Serial No. 09/285,325. Application

Serial No. 09/286,645 contains the same text as continuation-in-part Serial No. 09/474,517, which claims priority from Provisional Application Serial No. 60/114,097. Provisional Application Serial No. 60/114,097 is contains the same text as Serial No. 09/222,491, which became Patent No. 6,110,922, *i.e.* the subject of this reissue application. Serial No.

5 09/286,645 discloses numerous diaryl sulfides containing cinnamide groups; it has been abandoned in favor of continuation-in-part application Serial No. 09/541,795, filed March 31, 2000, and Serial No. 09/695,040, filed October 24, 2000, which are still pending. Serial No. 09/285,325 has been discussed in the previous paragraph.

Applicants have become aware of the possibility that part, **but only part**, of the information disclosed in Serial No. 09/285,477 may be prior art under 35 U.S.C. 102(g) and 35 U.S.C. 103 to the claims of this application. Thus, Applicants have become aware of the possibility that that the information disclosed in Serial No. 09/285,477, **except for the disclosure therein of diaryl sulfides containing cinnamide groups**, is "prior art" to all the claims of this application under 35 U.S.C. 102(g) and 35 U.S.C. 103. Applicants believe that 15 the information relating to cinnamide-containing diaryl sulfides disclosed in Serial No. 09/285,477 (including the applications incorporated by reference therein) is not prior art under 35 U.S.C. 102 (g) to any claim in this application which is entitled to the first priority date claimed, because such information is subsequent to the invention of the cinnamide-containing diaryl sulfides as claimed in this application. Applicants believe that the information relating 20 to cinnamide-containing diaryl sulfides disclosed in Serial No. 09/285,477 (including the applications incorporated by reference therein), except insofar as it relates to the use of cinnamide-containing diaryl sulfides in test methods of identifying negative regulators of LFA-1 binding to natural ligands, and in methods of identifying amino acids in a regulatory site to which the negative regulators bind, is not prior art to any claim in this application which is not 25 entitled to the first priority date claimed, because such information was invented by some or all of the inventors named in this application, all of whom had a duty to assign to the present assignee **at the time of invention**.

Therefore, the Examiner is asked:

(A) to examine the claims in this application which are entitled to the first priority date on the basis that the information disclosed in Serial No.

09/285,477, except for the disclosure therein of diaryl sulfides containing cinnamide groups and all the disclosed uses of such diaryl sulfides, is "prior art" under 35 U.S.C. 102(g) and 35 U.S.C. 103; and

(B) to examine the claims in this application which are not entitled to the first priority date on the basis that the information disclosed in Serial No.

09/285,477, except for the disclosure therein of diaryl sulfides containing cinnamide groups and all the disclosed uses of such diaryl sulfides other than their use in test methods for identifying negative regulators of LFA-1 binding to natural ligands and in methods of identifying amino acids in a regulatory site to which the negative regulators bind, is "prior art" under 35 U.S.C. 102(g) and 35 U.S.C. 103.

It is noted for the record that the above requests are made **only** for the purposes of the *ex parte* examination of *this* application and are not an admission that any part of Serial No. 09/285,325 or Serial No. 09/285,477 is prior art to any claim based on the disclosure of this application. In particular, Applicants do not admit, for any other purpose (*e.g.*, for the purposes of any interference proceedings involving this application, for the purposes of examination or interference proceedings involving any continuation, divisional, continuation-in-part or reissue application of this application, or for the purposes of any proceedings in connection with any Patent granted on this application or on any continuation, divisional, continuation-in-part or reissue application thereof (*e.g.* reexamination, interference or litigation proceedings involving such a Patent), that any part of Serial Nos. 09/285,325 and 09/285,477 is prior art under 35 U.S.C. 102 or 35 U.S.C. 103 to any claim based on the disclosure of this application.

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Enclosed is a check in the amount of \$ 180.00 to cover the cost of the IDS filed under 37 C.F.R. 1.97(c)(2). The Commissioner is hereby authorized to charge any other additional fees, or credit any overpayment, associated with this communication to Deposit Account No. 19-2090.

5 It is believed that this disclosure complies with the requirements of 37 C.F.R. 1.56 and the Manual of Patent Examining Procedure, Section 707.05(b). If for some reason the Examiner considers otherwise, it is respectfully requested that the undersigned be called so that any deficiencies can be remedied.

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Respectfully submitted,

SHELDON & MAK
a Professional Corporation

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Date: 7/29/02

By 
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